

REMARKS

Claims 1-38 and 40-42 are currently pending in the subject Application. Claim 39 has been cancelled without prejudice and without disclaimer of subject matter.

Claims 1, 3, 7, 20-38, 40 and 41 have been amended. Claim 42 has been added. The paragraph beginning at page 16, line 20 of the specification has been replaced. No new matter has been added.

In paragraph 1 of the Office Action, the drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) on the grounds that they include the reference designator 330. The paragraph beginning at page 16, line 20 of the specification has been replaced with an amended paragraph that includes reference designator 330 corresponding to the "Name / Address" text shown in Fig. 3b. It is believed that this amendment to the specification obviates the rejection to the drawing figures and withdrawal of this objection is respectfully requested.

In paragraph 2 of the Office Action, claims 3 and 22 were objected to on the grounds that the recitation "sub profiles *comprise* a franking profile, a naming profile or a dynamic function profile" appeared to be a grammatical error. Claims 3 and 22 have been amended to correct the grammar and place them in proper form under U.S. patent practice. It is believed that the amendments made to these claims address this objection. Accordingly, withdrawal of this objection is respectfully requested.

In paragraph 3 of the Office Action, claims 20-39 were objected to on the grounds that the preamble was "confusing". Claim 39 has been canceled, thereby rendering the objection to that claim moot. Claims 20-38 have been amended to more

clearly recite that these claims are directed to a method. Accordingly, it is believed the objection to claims 20-39 have been addressed and the withdrawal of this objection is earnestly solicited.

In paragraph 4 of the Office Action, claims 32 and 39 were objected to as appearing to be substantial duplicates of one another. Claim 39 has been cancelled without prejudice and without disclaimer of subject matter, thereby obviating this objection. Withdrawal of this objection is therefore respectfully requested.

In paragraphs 6-15 of the Office Action, Claims 3-11, 17, 22-30, 36 and 41 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as his invention. Claims 3, 7 and 22 have each been amended to remove the open-ended “comprising” and “or” language combination. In particular, Claims 3 and 22 have been amended to clearly state that the “sub profiles include at least one of a franking profile, a naming profile and a dynamic mail function profile.” Claim 7 has been amended to clearly state that the “dynamic mail service is one of a follow me mail service, a mail delivery notification service, a vanity stamp service and a bulk mail service.” It is believed that the amendments to Claims 3, 7 and 22 obviate the rejections under 35 U.S.C. 112, second paragraph. Accordingly, Applicant respectfully requests that the rejection to these claims be withdrawn.

Claims 4-11, 17, 23-30 and 36 were rejected under 35 U.S.C. 112, second paragraph, by virtue of their dependency on one or another of rejected Claims 3, 7 and 22. As noted above, because Claims 3, 7 and 22 have been amended to address the

rejection under 35 U.S.C. 112, second paragraph, and are now believed allowable, Claims 4-11, 17, 23-30 and 36 are believed allowable. Accordingly, Applicant respectfully requests that the rejection to Claims 4-11, 17, 23-30 and 36 be withdrawn.

Claim 41 was rejected in paragraph 15 of the Office Action under 35 U.S.C. 112, second paragraph, as being unclear whether “software alone is capable of performing the step of executing the selected mail services”. Claim 41 has been amended to clearly claim elements capable of execution by a computer.

In paragraph 17 of the Office Action, Claim 41 was rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter. Claim 41 has been amended to place it in proper form under U.S. patent practice. As amended, Claim 41 has been re-written as a storage medium method claim using generally accepted pre-ambble language.

Claims 1, 20, 40, 41 and 42 are independent.

In paragraph 19 of the Office Action, Claims 1-3, 5-7, 10, 13-14, 18-22, 24-26, 29, 32-33, and 37-41 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. Publication No. 2002/0029152 (“Lee”).

Features of amended independent Claims 1 and 40 include a “user profile having a designated time frame for which the user profile is active” and that the mail services are executed “during the designated active time frame”. These features are not taught or suggested by Lee.

Lee is directed to tracking a mail item through the mailing system. See Abstract. To accomplish this, Lee teaches associating a sender generated ID with an ID generated by the carrier. Id. The location of the item within the carrier mailing system is

associated with the carrier ID and stored in a database such that when the sender queries the carrier system, a database lookup is performed and the sender is informed of the location of the mail item. Id. and [0006] and [0007] of Lee. In contrast to amended Claims 1 and 40, since Lee is concerned with mail item tracking, Lee does not teach that the user profile includes any designation of a “time frame for which the user profile is active”. Further, there is nothing in Lee that teaches or suggests that mail services based on the user profile are only performed “during the designated active time frame.” For at least this reason, Applicant respectfully asserts that Claims 1 and 40, as amended, are patentable over Lee. Applicant therefore requests that the rejections to Claims 1 and 40 be withdrawn.

Features of amended independent Claims 20 and 41, include “storing a designated time frame for which the user profile is active”. Another feature of amended Claim 20 is “executing one or more mail services during the designated active time frame as defined in the user profile.” These features are not taught or suggested by Lee.

As discussed above with respect to Claim 1, Lee is concerned with providing a sender the ability to track progress of the mail item through the carrier system. As such, Lee does not contemplate establishing time frames during which the user’s profile is active and, in contrast to Claims 20 and 41, does not teach or suggest storing such a designated time frame and, with respect to Claim 20, executing one or more mail services during “the designated active time frame.” Accordingly, Claims 20 and 41 are believed allowable and the withdrawal of the rejections of these claim is earnestly solicited.

Dependent Claims 2 and 21 recite that the “profile comprises one or more sub profiles.” Applicant respectfully traverses this rejection. Paragraphs 21 and 32 of the Office Action refer to paragraph [0020] of Lee and take the position that Lee’s premium service records are the same as Applicant’s sub profiles. As described in Lee, records 46 are merely entries in a database that are used to track the progress of the mail item through the mail system. FIG. 5, paragraph [0023]. Lee’s records 46 are for mail tracking and do not define any user information. There is no teaching or suggestion in Lee that these time/date/location records in any way define mail services based on a user profile. As such, it is submitted that Claims 2 and 21 are patentable over Lee and the withdrawal of the rejection of these claims is requested.

In paragraph 46 of the Office Action, Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, et al., in view of Lorch, et al., (Intl. Pub. No. WO 02/51051). Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 each depend, directly or indirectly, from one or another of independent Claims 1 and 20. Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 recite additional limitations, which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Accordingly, Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 are believed patentable at least by virtue of the patentability of their respective base independent claims. Applicant therefore requests that the rejection to Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 be withdrawn.

In paragraph 59 of the Office Action, the Examiner has rejected Claims 9 and 28 under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. Claims 9 and 28 each

depend, directly or indirectly, from one or another of independent Claims 1 and 20.

Claims 9 and 28 recite additional limitations, which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Accordingly, Claims 9 and 28 are believed patentable at least by virtue of the patentability of their respective base independent claims. Applicant therefore requests that the rejection to Claims 9 and 28 withdrawn.

In paragraph 62 of the Office Action, the Examiner has rejected Claims 11 and 30 under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. in view of Official Notice. As an initial matter, Claims 11 and 30 recite additional limitations, which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Accordingly, Claims 11 and 30 are believed patentable at least by virtue of the patentability of their respective base independent claims.

Applicant therefore requests that the rejection to Claims 11 and 30 withdrawn.

In addition, Applicant respectfully asserts that it is not common knowledge that one using registered pseudo names would know to use “opt-out lists of potential customers that do not wish to receive bulk mailings” within the context of the present invention. In particular, the Office Action makes a generalized statement about the use of bulk mailing opt out lists, then, without any explanation as to why or how one would be motivated to use an opt-out list in connection with pseudo names, reaches the obviousness conclusion. In other words, the Office Action seems to take Official Notice that one of skill in the art would know or be motivated to combine the cited reference with what the Examiner asserts is common knowledge. However, the Office Action

provides no explanation as to why one would be so motivated and provides no reference to any teaching to support this conclusion. In accordance with M.P.E.P. § 2144.03 C, Applicant requests that the Examiner provide documentary evidence supporting his conclusion. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.

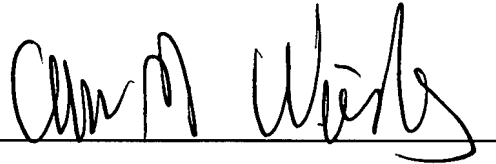
A feature of new Claim 42 is “storing a designated time frame for which the user profile is active.” As noted above, this feature is not taught or suggested by the art of record. Accordingly, Claim 42 is believed patentable.

This entire application is now believed to be in condition for allowance. Consequently, such action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

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Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Alan M. Weisberg", is written over a horizontal line.

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